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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Patrick G. Ryan

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06/06/2005

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,707

Applicant(s)

RYAN ET AL.

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>(2 pages)</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Preliminary Matters

1. The preliminary amendment filed 10 June 2004 has been entered.

Drawings

2. The drawings are objected to because of the following:
 - a. The column headings in Figure 5 are not aligned.
 - b. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of determining a current product surplus, as recited in claim 30, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: P.14, L.7, it appears that exit is misspelled. Appropriate correction is required.

Claim Objections

4. Claims 24 and 33 are objected to because of the following informalities:
- a. Claim 24 does not end with a period; however the claim has been treated as though a period were placed after the word buyers on line 3.
 - b. Claim 33, lines 10-11, “a current product demand or at least a portion of said plurality of products for at least a portion of said plurality of buyers” appears to be related to the current product demand recited at line 5, i.e., the current product demand for at least a portion of said plurality of products for at least a portion of said plurality of buyers. Further, line 11-12, “an available supply of products from at least a portion of said plurality of suppliers” appears to be related to the available supply recited at line 8, i.e., the available supply of products for at least a portion of said plurality of suppliers.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The subject matter added in claim 30 does not receive benefit of the filing date of the application because it was not filed with the application papers.

The claimed step of determining a current product surplus from each buyer based on a desired inventory profile for that buyer is not described in the specification. The term “surplus” is not described in the specification, thus the specification does not support the claimed embodiment. Further, if the general meaning of the term surplus were used, the specification does not reasonably convey to one of ordinary skill how the step of determining surplus based on the inventory profile is accomplished, i.e., that the inventor had possession of the invention as recited in claim 30, at the time the application was filed.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 3, 12, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 2, the recitation of “designating a market for only those product classes which exceed both the supply and demand threshold values” should be related to the earlier recited step of “designating a market for each of said determined ones of said product classes.” The recitation of “a market” at claim 2 is not clear whether applicant is further limiting the “market” recited in claim 1 or adding a step to the designating step of

claim 1. If applicant intends to further limit claim 1, the scope of claim 2 is further indefinite because the claim would be attempting to omit the designating step of claim 1 and substitute therefore, the designating step of claim 2. Claim 2 is a dependent claim and must include all the features and limitations of the claim(s) upon which it depends, thus to attempt to omit features from claim 1 would render the claim indefinite and unclear as to the metes and bounds of patent protection desired. Further, the claim is unclear as to how the “product classes” recited in claim 2 are related to or distinguished from the “determined product classes” recited in claim 1.

b. Regarding claim 3, the recitation of “a plurality of markets” associated with each of the steps of collecting, determining, aggregating, comparing, obtaining, and designating is indefinite insofar as each of the listed steps is not related to a market, i.e., only the step of designating a market is so related. Therefore, the claim is unclear whether the plurality of markets is defined at the collecting step, determining step, etc. and if so, then how is the designating step performed (the step designating a market for each of the determined ones of the products is performed after all of the other steps) in the combination of claim 3.

c. Regarding claim 12, the indefiniteness pointed out with regard to claim 3 applies to claim 12.

d. Regarding claim 26, the claim recites product demand based on two Markush groupings:

- i. at least one factor selected from A, B, C and
- ii. at least two or more of A, B, and C

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the claim is unclear whether product demand is based on one factor or two or more factors included in the group “A, B, and C.” Clarification is required. The scope of the claim has been interpreted as at least one factor selected from A, B, and C.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-30 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. Regarding claims 1-10, the claims are not within the technological arts. The preamble recitation of “computer-implemented” is of no import to the scope of the claim insofar as applicant has not included any computer implementation in the body of the claim. All of the steps recited in the claims can be performed by a human using paper and pencil.

b. Regarding claims 11-19, the claims are not within the technological arts. The preamble recitation of “computer-implemented” is of no import to the scope of the claim insofar as applicant has not included any computer implementation in the body of the claim. All of the steps recited in the claims can be performed by a human using paper and pencil.

c. Regarding claims 20-30, the claims are not within the technological arts. The preamble recitation of “computer-implemented” is of no import to the scope of the claim insofar as applicant has not included any computer implementation in the body of the

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claim. All of the steps recited in the claims can be performed by a human using paper and pencil.

d. Regarding claim 33, the claim is not within the technological arts. The preamble recitation of “computer-implemented” is of no import to the scope of the claim insofar as applicant has not included any computer implementation in the body of the claim. All of the steps recited in the claims can be performed by a human using paper and pencil.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 20, 21, 24-26, 28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Choudhury (article, Uses and consequences of electronic markets: an empirical investigation in the aircraft parts industry).

Regarding claims 20 and 24, Choudhury teaches collecting inventory information (p. 473, col. 1, an electronic market to exchange information; fig. 2 inventory levels; p. 483, col. 1, purchases for inventory and aggregating expected consumption forecasts over the fleet) from a plurality of buyers (p.484, lines 3-17, communication among buyers (plural) and sellers (plural)); determining demand based on desired inventory profile and collected inventory information (p. 483, and col. 1); identifying an available supplier (p. 484, col. 1, lines 3-17, when a product (part) is requested the names of all sellers are listed); notifying at least a portion of the buyers (p.

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484, col.1, lines 3-17, the requesting buyer is notified of product (part) availability) that have a current demand which corresponds to an available product supply (p. 484, col. 1, lines 3-17, a buyer requests a listing). The term marketing as used in the preamble is broad and has been interpreted to include notifying the buyer after a query is made about a particular product, or part as taught in Choudhury.

Regarding claim 21, Choudhury inherently includes periodic repetition of the steps insofar as Choudhury discloses a method used by various buyers and sellers when inventory or other constraints require that the buyer request products from a seller.

Further regarding claim 24, Choudhury discloses a method wherein the buyer requests information for a part (p.484, col. 1, lines 3-17) each time the buyer requests information, the method step of collecting information for each of a plurality of products from each of a plurality of buyers has been met.

Regarding claim 25, Choudhury discloses a method used by a plurality of buyers; therefore, the information collected is from a plurality of buyers for a plurality of parts (p. 484, col. 1, lines 3-17, communication among buyers and sellers).

Regarding claims 26 and 28, Choudhury discloses demand based on manual indication by the buyer (p. 484, col. 1, lines 3-17, the buyer requests listings of sellers for a part).

Regarding claim 30, Choudhury discloses the listing of surplus inventory on the inventory locator service (p. 483, col. 2, second paragraph). The term surplus is not defined in the specification. For purposes of this action, the claim has been interpreted broadly to include product in excess of demand.

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Regarding claim 31, Choudhury discloses a system for performing the steps of collecting, determining, identifying, and notifying, as discussed with regard to claim 20 above.

Regarding claim 32, Choudhury discloses the system for facilitating marketing comprising a data input device (fig. 1, buyer 1-5), a calculating device (fig. 1, electronic market), a matching device (fig. 1, electronic market), and an output device (inherently disclosed, e.g., information requested by the buyer in a search for sellers would be displayed for the buyer's consideration).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Angeles (article, Revisiting the role of Internet-EDI in the current electronic commerce scene) teaches using the Internet to exchange business documents and at page 10 teaches an automotive network exchange between manufacturers and suppliers.
- Harreld (article, Suppliers get their due) teaches a method and system for linking buyers and suppliers via a supply chain component, and helps suppliers keep track of buyer inventory.
- Lee (article, Do electronic marketplaces lower the price of goods?) teaches the use of electronic market to sell used vehicles through a market maker or broker. The buyer can determine need by browsing auction catalog and bidding or by downloading images of vehicles offered for sale through the market and add the vehicle to a bidding list at request of a client.

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- Woolston (US-5845265) teaches an electronic market for used goods; however, the goods are posted in an online catalogue that is browsed by prospective buyers.
- Bixler (US-5745882) teaches a classified ad system that allows a buyer to filter the classified ads before viewing.
- Fraser (US-5664115) teaches online matching software that screens buyers based on criteria and transmits offers to sellers that meet the criteria; however, the buyer searches a catalogue rather than describing an item of interest to the buyer.
- Clemens (cited by applicant, WO-01/11519-A2) teaches (pp. 9-10) an online car sales service (CARPOINT) that includes a buyer selecting a product category, searching a database of available seller inventory, followed by negotiating price or obtaining an online price quote. Clemens (pp. 12-13) includes a network-based buyer-driven product identification and purchase system. Buyers are ensured targeted offers that meet purchase criteria. Clemens (p. 3, l. 16-25) teaches product categories and a plurality of markets (i.e., geographic proximity p. 38, l. 19). The software can collect the supplier inventory information (p. 38, l. 7-9) and periodic collection of information (p. 37, l. 29-33).
- Malone (article, Electronic markets and electronic hierarchies) teaches the use of electronic database sharing among buyers (producers) and suppliers.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728.

The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamara L. Graysay
Examiner
Art Unit 3623

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